

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated November 19, 2008 ("*Final Office Action*"). At the time of the Office Action, Claims 1-5, 7, 8, and 10-32 were pending and Claims 17-28 were withdrawn. The Examiner rejects Claims 1-5, 7, 8, 10-16, and 29-32. Applicant amends Claims 5 and 29. Applicant submits that no new matter has been added by these amendments. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Double Patenting

The Examiner provisionally rejects Claims 1-5, 7, 8, 10-16, and 29-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 and 35-46 of copending Application No. 09/817,353 ("353"). As this is a provisional double patenting rejection, Applicant defers the decision to file a terminal disclaimer or traverse the rejection until the Examiner has indicated that both the present Application and copending Patent Application 09/817,353 include allowable subject matter. However, Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

Section 103 Rejections

The Examiner rejects Claims 1-2, 7-8, 13, 15, and 30-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("Arganbright") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). The Examiner rejects Claims 3-4, 10-12, 14, 16, and 29 under 35 U.S.C. 103(a) as being unpatentable over *Arganbright* in view of *Cybul*, in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice. Applicant requests reconsideration for the reasons discussed below.

A. Claims 1-2, 7-8, 13, 15, and 30-32 are Allowable over the Proposed *Arganbright-Cybul* Combination

In the previous Response submitted on July 5, 2008, Applicant made three distinct arguments demonstrating the patentability of independent Claim 1 over the proposed *Arganbright-Cybul* combination. Applicant appreciates the Examiner's thoughtful consideration of this case. Because Applicant continues to believe that the claims are in condition for allowance, however, Applicant has not amended the claims. Applicant reiterates and expands upon the previously presented arguments and addresses the Examiner's response to each of Applicant's arguments below.

- 1. The proposed combination does not disclose, teach, or suggest *"receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing."***

As a first example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing," as recited in Claim 1.

In the previous *Office Action*, the Examiner acknowledged that neither *Arganbright* nor *Cybul* disclose the recited claim elements. (*Office Action delivered May 16, 2008*, page 5). While the Examiner continues to acknowledge in the *Final Office Action* that *Arganbright* does not disclose the recited claim elements, the Examiner now relies upon *Cybul* for disclosure of the recited claim elements. (*Final Office Action*, page 5). Applicant respectfully disagrees.

The cited portion of *Cybul* merely discloses “a list builder tool” that “efficiently find[s] and select[s] the past shopping history of respective shoppers and import[s] that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based “list builder tool.” The application finds and selects items previously purchased by the customer. The selection, however, is not by a customer, via a web access tool. The selection is not a click on the particular item of merchandise, and the selection does not identify a particular item of merchandise for returns processing. Accordingly, it continues to be Applicant’s position that neither *Arganbright* nor *Cybul* (or their proposed combination) disclose, teach, or suggest “receiving an **electronic selection, from the customer, via the web access tool**, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing**,” as recited in Claim 1. The recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally and as previously shown in the Response submitted by Applicant on July 5, 2008, Applicant continues to submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing.

Arganbright discloses that the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. “If the user selects “return,” an online return form 2706 is presented to the user.” (Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return,

product description, and an invoice number.” (Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Applicant’s claim language would not have been obvious to one of ordinary skill in the art. As discussed above, *Cybul* relates to a system for online shopping that “takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor’s POS system “supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer,” the information may be extracted from the vendor’s POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer’s in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer’s computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Applicant’s recited step of “receiving an **electronic selection, from the customer, via the web access tool**, the electronic selection identifying a particular

item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing,**” as recited in Claim 1.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

2. ***The proposed combination does not disclose, teach, or suggest “in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server.”***

As a second example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server,” as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for the operation of initiating a returns process by a returns server in response to a selection of an item. (*Final Office Action*, pages 4-5). Specifically, the examiner states “*Arganbright* teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35).” (*Final Office Action*, page 10). Initially, Applicant respectfully notes that Applicant’s claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Applicant’s claim recites “initiating a returns process for the particular item of merchandise . . . by a returns server,” and this operation is not disclosed in *Arganbright*.

Arganbright merely discloses that “[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, this portion refers to the selection of either a “return” button or an “exchange” button by a user. Applicants point out that the selection of the “return” button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the “return” button occurs before an item of merchandise is identified for return. The mere presentation of form before the identification of the product to be returned is not analogous to “initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction,” as recited by Applicant’s amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing.

Applicant additionally notes that in the *Final Office Action* the Examiner relies upon *Cybul* for disclosure of the electronic selection of the particular item of merchandise and upon *Arganbright* for the operation of initiating a returns process by a returns server. (*Final Office Action*, pages 4-5). However, Applicant’s claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites “in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server.” Thus, a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server.

To the extent that *Arganbright* discloses initiating a returns process by a returns server (which Applicant expressly disputes above), such returns process is not “in response receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise” from the customer. Applicant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section A(1) of this Response, *Cybul* does not even disclose the recited “electronic selection comprising the click on the particular item of merchandise” from

the customer. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Applicants respectfully submit that the piecemeal rejection of Applicant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Applicant’s claim.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

3. The proposed combination does not disclose, teach, or suggest “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction.”

As a third example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction,” as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for disclosure of receiving the electronic request to initiate return processing and upon *Cybul* for disclosure of accessing a database to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. (*Final Office Action*, pages 4-5). Again, Applicant notes that Applicant’s claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, an electronic request to initiate return processing is first received from a customer. Then, in response to that electronic request, a database is accessed to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. To the extent that *Cybul* discloses accessing a database to obtain transaction information associated with the customer, the

operation is not “in response to receiving the electronic request to initiate return processing from the customer.” The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Applicants respectfully submit that the piecemeal rejection of Applicant’s claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Applicant’s claim.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

B. Claims 3-5, 10-12, 14, and 16 are Allowable over the Proposed *Arganbright-Cybul-Roman-Official Notice* Combination

Claims 3-5, 10-12, 14, and 16 depend upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claims 3-5, 10-12, 14, and 16 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 3-5, 10-12, 14, and 16 include the limitations of Claim 1. Additionally, dependent Claims 3-5, 10-12, 14, and 16 recite further elements that distinguish Applicant’s claims over the prior art of record. Since Applicant has shown independent Claim 1 to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 3-5, 10-12, 14, and 16. Applicant remains ready to do so if it becomes appropriate.

C. Claim 29 is Allowable over the Proposed *Arganbright-Cybul-Roman-Official Notice* Combination

Claim 29 depends upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claim 29 is not obvious over the various combinations of references relied upon by the Examiner at least because Claim 29 includes the limitations of Claim 1. Additionally, dependent Claim 29 recites further elements that distinguish Applicant’s claims over the prior art of record.

In the *Final Office Action*, the Examiner acknowledges that “[n]either Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information.” (*Final Office Action*, page 8). However, the Examiner takes Official Notice that the claim elements are well known and old in the art. (*Final Office Action*, pages 8-9).

Applicants traverse the Examiner’s taking of Official Notice. Although the M.P.E.P. suggests that it might not be unreasonable for the examiner to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence, the M.P.E.P. specifically states that Official Notice is only appropriate “provided the facts so noticed are of notorious character and serve only to “fill in the gaps” which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection.” (M.P.E.P., §2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.). Such is not the case here. For example, Claim 29 recites “the customer information comprises customer-specific credit information or customer-specific shipping information.” There is no disclosure in either *Arganbright* or *Cybul* of these claim elements. Additionally, the recited claim elements do not “fill in the gaps” of *Arganbright* and *Cybul*. Additionally, the Examiner has provided no evidence to support the Examiner’s contention that Applicant’s customer information comprising “customer-specific credit information or customer-specific shipping information,” as recited in Applicant’s dependent Claim 29, is indeed “old and well known” in the art.

In this case, it would not be appropriate for the examiner to take official notice of the claim elements of Claim 29 without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P., §2144.03). Accordingly, to the extent that the Examiner maintains this rejection based on “Official Notice,” “well-known art,” common knowledge, or other information within the Examiner’s personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claim 29.

No Waiver

Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

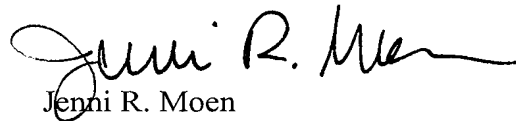
CONCLUSION

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 415-4820.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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